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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,897	12/09/2003	Andrew M.K. Pennell	019934-003720US	6930
20350	7590	01/26/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BERNHARDT, EMILY B	
			ART UNIT	PAPER NUMBER
			1624	
DATE MAILED: 01/26/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/732,897

Applicant(s)

PENNELL ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-59 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-53, drawn to compounds, compositions where $n=1$, $Ar1$ = phenyl, naphthyl and HAr = pyrazoles and benzopyrazoles, classified in class 544, subclass 371; class 514 subclasses 254.05-254.07.
- II. Claims 1-3 and 53, drawn to compounds, compositions where $n=1$, $Ar1$ = pyridyl, pyrazinyl, pyridazinyl and pyrimidyl and HAr = pyrazoles and benzopyrazoles, classified in class 544, subclasses such as 238, 295, 357, 364; class 514 subclasses 252.11, 252.02, 252.19.
- III. Claims 1 and 53, drawn to compounds, compositions where $n=1$ and $Ar1$ = remaining rings not provided for in I or II and HAr = pyrazoles and benzopyrazoles, classified in class 544, subclasses such as 180, 182, 277, 353; class 514, subclasses 241, 242, 249.
- IV. Claims 1-6, and 53, drawn to compounds, compositions where $n=1$ and HAr = other rings not provided for in I-III, classified in class 544, subclasses such as 366-371; class 514 subclasses 254.01-254.04, etc.
- V. Claims 1-6, and 53, drawn to compounds, compositions where $n=2$, classified in class 540, subclass 575.
- VI. Claims 54-58, drawn to multiple uses employing compounds where $n=1$ and $Ar1$ = phenyl, naphthyl and HAr = pyrazoles and benzopyrazoles, classified in class 514, subclass 254.05, etc.

- VII. Claims 54-58, drawn to multiple uses employing compounds where $n=1$ and $Ar1=$ pyridyl, pyrazinyl, pyridazinyl, pyrimidyl and $HAr=$ pyrazoles and benzopyrazoles, classified in class 514, subclass 252.02, etc.
- VIII. Claims 54-58, drawn to multiple uses employing compounds where $n=1$ and $Ar1=$ remaining rings not provided for in VI-VII, classified in class 514, subclass 241, etc.
- IX. Claims 54-58, drawn to multiple uses employing compounds where $n=1$ and $HAr=$ other rings not provided for in VI-VIII, classified in class 514, subclass 254.01, etc.
- X. Claims 54-58, drawn to multiple uses employing compounds where $n=2$, classified in class 514, subclass 218.
- XI. Claim 59, drawn to multiple uses employing compounds of VI-X and additional active ingredients, classified in class 514, subclasses various as determined by the exact nature of active ingredients employed.

If Group IV or IX is elected applicants must pick a specific HAr ring and $Ar1$ groups as was done in I-III. If one of Groups VI-XI is elected a specific use must be selected and additionally for Group XI applicants must pick a compound group (i.e. one of VI-X) and a single species from this group and an ultimate species as the co-ingredient.

In addition to an election of any of the above Groups applicants must also elect a single species within the elected group to which claims may be limited should generic claims be found not allowable.

The inventions are distinct, each from the other because of the following reasons:

Compounds within I-V relate to compounds of considerable structural dissimilarity in view of the varying rings at Ar1 and HAr as well differing size cores. Thus they are separately classified based at the very least on species/preferred embodiments recited in various claims. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group. Different issues of patentability would be expected in view of the structural dissimilarity for compounds of I vs II vs III, etc. as a whole which is evident at the very least by the many provisos recited directed to differing aspects of applicants' compounds.

Inventions I-V and VI-X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the compounds have more than one use as evidenced at the very least by the method claims encompassing whole ranges of disorders. It is also noted that Groups I-V are not entirely commensurate with use groups VI-X as the provisos make some of the compound groups narrower. Thus different issues of patentability may arise. Note the following rejoinder reminder should method claims be presented that are commensurate with elected compound group.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP §

821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Compounds employed in VI-X (vs. XI) may be old or obvious when separately employed but may be patentable due to superior, or synergistic properties not present for the individual components. Within group XI there is more than one invention as the claims embrace multiple combinations for a variety of uses which require independent searches and which are not art-recognized equivalents in the art.

Because of its length and complexity the restriction is being set forth in writing.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



Emily Bernhardt
Primary Examiner
Art Unit 1624